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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,684	12/08/2003	Edward J. Vasei	81079 7304	3287
22242 7590 04/13/2007 FITCH EVEN TABIN AND FLANNERY 120 SOUTH LA SALLE STREET SUITE 1600 CHICAGO, IL 60603-3406			EXAMINER CLEMENT, MICHELLE RENEE	
			ART UNIT	PAPER NUMBER
			3641	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/13/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/731,684	<b>Applicant(s)</b> VASEL ET AL.	
	<b>Examiner</b> Michelle (Shelley) Clement	<b>Art Unit</b> 3641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 February 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-15 and 17-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-15 and 17-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date: _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____   | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. In view of the amendment filed 2/26/07 and the following action, the Office Action dated 10/26/06 is hereby withdrawn.

#### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-15, 18-19, 21, 23 and 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Abbott et al. (US Patent # 3,650,213) in view of Oberfell et al. (US Patent # 3,053,185). Abbot et al. discloses a projectile system for use in delivering a substance to a target comprising a projectile comprising a first part, a second part that is at least partially hollow, wherein the second part is secured with the first part to seal the hollow portion defining a volume, the projectile is non-spherical, an inhibiting substance contained within the volume and stabilizing fins secured with the second part along an exterior of the second part and a block (reference 41), made of foamed polyethylene, positioned proximate to the stabilizing fins wherein the inhibiting substance is dispersed into a cloud upon impact of the projectile with a target. The first part is at least partially hollow where the hollow portion of the first part cooperates with the hollow portion of the second part defining a volume such that the inhibiting substance is contained within the volume. The second part tapers to a smaller diameter away from the first part and the second part has a length that is greater than a width of the first part. Comprising a shell, an ignitable substance (i.e. means for launching the projectile) positioned within the shell, wherein

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the ignitable substance propels the projectile from the shell upon ignition of the ignitable substance. The block is positioned within the shell adjacent the propulsion block and the ignitable substance includes primer positioned within the shell such that the primer when ignited propels the propulsion block which forces the projectile from the shell. Abbot et al. discloses the projectiles can be launched from cases, it is inherent that any number/plurality of projectiles of Abbot et al. can be provided and any number/plurality of cases (means for launching the plurality of projectiles) can also be provided. The plurality of projectiles can also be launched in a set or in sub-sets within a limited time (note 24 hours could constitute a limited time) and they are intended to contact a target along a path across the target. Although Abbott et al. does not expressly disclose the purpose of the block to maintain *substantially* all of a propulsion force behind the block and to evenly distribute the propulsion force to the projectile, Oberfell et al. does. Oberfell et al. teaches an expandable wad for shotgun shells made of foamed polyethylene that expands in order to utilize the driving force of the gas from the burning gun powder. Oberfell et al. and Abbott et al. are analogous art because they are from the same field of endeavor: shot cartridges. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the expandable propulsion block as suggested by Oberfell et al. with the projectile system as disclosed by Abbott et al. The suggestion/motivation for doing so would have been to obtain a projectile system in which all the propulsive forces of the propulsion gases were utilized for propelling the projectile. The [a)statements of intended use or field of use, b)"adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"] clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably

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distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

3. Claims 20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abbott et al. and Oberfell et al. as applied to claims 13, 18, 19,23 and 24 above, and further in view of Fedida (US Patent # 5,821,450). Although Abbott et al. does expressly disclose the inhibiting substance including capsaicin, Fedida does. Fedida teaches an improved inhibiting substance for use in incapacitating systems. Abbott et al., and Fedida are analogous art because they are from the same field of endeavor: incapacitating systems. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the inhibiting composition including capsaicin as suggested by Fedida with the system as disclosed by Abbott et al. and modified by Oberfell et al. The suggestion/motivation for doing so would have been to obtain an incapacitating system with the improved properties as suggested by Fedida.

4. Claims 17 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abbott et al. and Oberfell et al. as applied to claims 12-15 and 18-20 above, and further in view of Barr

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(US Patent # 3,865,038). Although Abbott et al does not expressly disclose the projectile system wherein the first part is reusable and *generally* non-frangible with support structures, Barr does. Barr teaches an inhibiting projectile comprising a *generally* non-frangible nose section that can be reused and comprising support structures. Abbott et al. and Barr are analogous art because they are from the same field of endeavor: inhibiting projectiles. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the nose structure as suggested by Barr with the projectile system as disclosed by Abbott et al. and modified by Oberfell et al. The suggestion/motivation for doing so would have been to obtain a projectile system with less waste.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle (Shelley) Clement whose telephone number is 571.272.6884. The examiner can normally be reached on Monday thru Thursday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571.272.6873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Michelle (Shelley) Clement  
Primary Examiner  
Art Unit 3641